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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/805,719

03/22/2004

Carmen Flosbach

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EXAMINER

MCCLELLAND, KIMBERLY KEIL

ART UNIT

PAPER NUMBER

1734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/805,719

Applicant(s)

FLOSBACH ET AL.

Examiner

Kimberly K. McClelland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose removing the foil from the transparent coating such that the entire transparent coating together with the image remains on the substrate. Applicant claims that by not disclosing a portion of the transparent layer is transferred, then the current application must show transferring the entire transparent layer. Applicant also points to page 11, lines 1-3 and page 12, lines 4-7 to demonstrate the entire transparent layer is transferred, but these passages do not explain how the entire transparent coating is transferred. Furthermore, a lack of disclosure to the transferring of a portion of the transparent coating is not a positive recitation of the current claim language.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,527,898 to Nakamura in view of in view of U.S. Patent No. 6,486,903 to Wagner.
5. With respect to claim 1, Nakamura discloses a method of using a transfer sheet, including a) providing a substrate (7) to be provided with an image (3) covered with a first transparent (column 8, lines 12-13) coating layer (2) and providing a backing foil consisting of a foil (1), one side having a first uncured or at most partially cured transparent coating (2), optionally (column 9, lines 53-55), a further transparent coating (4) and, on the side of the first coating remote from the foil, having an image thereon (3), wherein the image is applied by printing (column 9, lines 4-5); b) applying the backing foil with its coated side provided with the image onto the substrate (See Figures 1-3); c) curing of at least the first transparent coating (column 10, lines 31-33); and d) removing the foil from the first transparent coating such that the entire transparent coating, together with the image, remains on the substrate, wherein curing according to process step c) proceeds before and/or after removal of the foil (column 10, lines 24-26).
6. Nakamura discloses that the pattern layer may be provided by printing (column 9, lines 4-5). Although they do not specifically disclose that the printing is accomplished by way of ink-jet printing, it would have been obvious to one of ordinary skill in the art at

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the time of invention to utilize such a printing method in the invention of Nakamura motivated by the fact that Wagner, also drawn to a process for the production and use of a transfer film comprising a carrier (backing); a radiation curable coating on the carrier; and an image disposed on the transparent coating (abstract; Figures 1-6; column 4, lines 23-42), disclose that the printing of the image may be accomplished by any known method including ink-jet (column 6, lines 50-55).

7. As to claim 10, Nakamura discloses the first transparent coating is thermally curable and curing proceeds in step c) by supply of thermal energy by means of a method selected from the group consisting of radiant heating, convection, induction heating, contact heating and any desired combination thereof (column 10, lines 16-25).

8. As to claim 11, Nakamura discloses the first transparent coating is curable by means of high-energy radiation and the curing in step c) proceeds by irradiation with high-energy radiation selected from the group consisting of electron beam radiation and UV radiation (column 10, lines 34-35).

9. As to claim 12, Nakamura discloses the curable coating composition is a coating composition curable thermally and by means of high-energy radiation and the curing in step c) proceeds by supply of thermal energy by means of a method selected from the group consisting of radiant heating, convection, induction heating, contact heating and any combination thereof and by irradiation with high-energy radiation selected from the group consisting of electron beam radiation and UV radiation (column 8, lines 52-56; column 10, lines 34-37).

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10. As to claim 13, Nakamura discloses the transparent coating layer of step a) comprises a coating selected from the group consisting of thermally curable coatings, coatings curable by means of high-energy radiation and coatings which are curable by means of high-energy radiation and additionally by thermal means (column 10, lines 31-37).

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,527,898 to Nakamura in view of in view of U.S. Patent No. 6,486,903 to Wagner as applied to claims 9-13 above, and further in view of U.S. Patent Application Publication No. 2004/0028881 to Yoshihara et al.

12. With respect to claim 14, Nakamura discloses the use of a radiation-curable protective layer but are silent as to the inclusion of an inorganic filler, in an amount relative to the resin solids content.

13. Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize an inorganic filler in the radiation-curable transparent protective resin of Nakamura motivated by the fact that Yoshihara et al., also drawn to methods for forming a radiation-curable transparent protective layer (See abstract), discloses that the inclusion of an inorganic filler at about 20 wt% of the resin solids content (See paragraph 0077). The motivation would have been to enhance hardness of the protective layer (See paragraph 0005).

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14. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,527,898 to Nakamura in view of in view of U.S. Patent No. 6,486,903 to Wagner and of U.S. Patent Application Publication No. 2004/0028881 to Yoshihara et al. as applied to claim 14 above, and further in view of U.S. Patent No. 6,245,382 to Shvartsman et al.

15. With respect to claim 15, Nakamura does not disclose the optional transparent coating contains 1 to 20 wt.%, relative to the resin solids content, of an inorganic filler.

16. Shvartsman, also drawn to methods for the protection of images utilizing a transferable radiation-curable transparent protective layer, disclose the inclusion of more than one layer of protective coating displays a substantial improvement in protection from solvents, plasticizers, and U.V. radiation (abstract; column 21, line 66 to column 22, line 21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the second transferable radiation-curable protective layer as taught by Shvartsman for the optional adhesive coating in Nakamura. It would have been obvious to one of ordinary skill in the art at the time of invention to provide the method resulting from the references as combined in sections (15-17), above, with two layers of radiation-curable transparent having the same resin solids composition of 1 to 20 wt.%, relative to the resin solids content, of an inorganic filler.

17. As to claim 16, Nakamura does not disclose transparent coating layer of step a) and said optional further transparent coating layer of step a) have the same resin solids composition.

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18. Shvartsman, also drawn to methods for the protection of images utilizing a transferable radiation-curable transparent protective layer, disclose the inclusion of more than one layer of protective coating displays a substantial improvement in protection from solvents, plasticizers, and U.V. radiation (abstract; column 21, line 66 to column 22, line 21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the second transferable radiation-curable protective layer as taught by Shvartsman for the optional adhesive coating in Nakamura. It would have been obvious to one of ordinary skill in the art at the time of invention to provide two layers of radiation-curable transparent having the same resin solids composition.

Response to Arguments

19. In light of the current amendment, the rejections of claims 9-16 under 35 U.S.C. 112, 2nd paragraph, the previous rejection is withdrawn.

20. Applicant's arguments filed January 26th, 2007 have been fully considered but they are not persuasive.

21. As to applicant's argument against the rejection of claims 9-16 under 35 U.S.C. first paragraph, examiner disagrees. The addition of the term "entire" introduces new matter that is not explicitly recited in the current specification. Applicant argues the "plain-meaning" doctrine includes such an interpretation. However, such a term is redundant, and provides no further meaning to the claim. In order to prevent new matter from being introduced into the current claims, the rejections are maintained.

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22. With respect to applicant's argument against the rejections of claims 9-16 under Nakamura in view of various secondary references, examiner disagrees. Applicant argues Nakamura exclusively discloses a required adhesive layer (4) in the current invention. However, applicant has ignored the embodiment disclosed in column 9, lines 53-55:

However, if the protecting layer 2 or the picture layer 3 has sufficient adhesiveness to the molded article 7, the adhesion layer may be omitted.

This passage clearly discloses an embodiment in which the adhesion layer 4 is optional in the surface protecting sheet. As a result, applicant's arguments are not persuasive.

23. Furthermore, the adhesion layer 4 of Nakamura is interpreted as meeting applicant's claimed further transparent coating. Applicant argues that no adhesive layer is required in the current invention. However, an applicant is entitled to be his or her own lexicographer and where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999). Applicant's specification (paragraph 0010) clearly discloses the transparent coating as a coating which is transparent in the cured state. Consequently, the transparent adhesion coating of Nakamura reads on applicant's claimed further transparent coating.

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Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly K. McClelland whose telephone number is (571) 272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris A. Fiorilla can be reached on (571)272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER
AU 1734

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kim McClelland

KKM